UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,374	04/21/2005	Jay A Berzofsky	4239-67016-02	4276

36218 7590 05/12/2008

KLARQUIST SPARKMAN, LLP
121 S.W. SALMON STREET
SUITE #1600
PORTLAND, OR 97204-2988

EXAMINER	
HUFF, SHEELA JITENDRA	
ART UNIT	PAPER NUMBER
1643	
MAIL DATE	DELIVERY MODE
05/12/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/532,374	BERZOFSKY ET AL.	
	Examiner	Art Unit	
	Sheela J. Huff	1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,6-11,13-18,21,26-28,32-34 and 38-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,6-11,13-18,21,26-28,32-34 and 38-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The amendment filed on 4/8/08 has been considered. Applicant's arguments are deemed to be persuasive-in-part.

Claims 1, 6-11, 13-18, 21, 26-28, 32-34 and 38-45 are pending.

The rejection under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendment.

Response to Arguments

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39-45 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The reasons for the rejection are set forth in the paper mailed 6/8/07.

Applicant again argues that the specification sets out methods for identifying agents which can inhibit tumor recurrence and that such experimentation is routine in the art. As stated in the rejection TGF-beta "has been shown to play a role in cell growth and differentiaion, immunosuppression, inflammation and the expression of

extracellular matrix protein" (this is was applicant's states on page 2 of the specification). Thus, it is clear that TGF-beta is involved in a multitude of different processes. Because of this, one skilled in the art would not readily believe that an assay that shows decreased TGF-beta activity would necessarily result in an agent that inhibit tumor recurrence.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 6-9, 11, 13-15, 21, 26-28, 32-34 and 38 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dasch et al US 6090383 in view of Barbera-Guillem US 6224866, and Rosenblum US 2005/0214307 (filed 3/17/95). Please note: Zavada et al US 6297041 has been removed from this rejection. The reasons for this rejection are of record in the paper mailed 11/8/07.

Applicant argues that treating a recurrence is not the same as inhibiting or preventing a recurrence and that treating and inhibiting are different concepts. In support of this, applicant provides a Declaration by applicant. At the end of paragraph 5 of this declaration, applicant states that "inducing the regression of (treating) a primary or secondary tumor is very different from inhibiting recurrence of a tumor, as the former reduces the size of an established tumor and the latter prevents the return of a variant form of a tumor". The Declaration goes to the elaborate on this statement. This statement contradicts applicant's definitions in the specification. On page 17 of the specification, applicant defines inhibiting tumor recurrence as not requiring absolute inhibition. The inhibition or reduction of tumor recurrence includes reducing the "recurrence of a tumor by measurable amounts" and as little as 5% reduction is acceptable. Furthermore, on page 17, applicant defines treatment as including prophylactic inhibition (ie tumor recurrence (lines 11+). Furthermore, on page 2, lines

24-25 of the specification, applicant states "the disclosure provides methods of inhibiting tumor recurrence in a subject by administering a **therapeutically effective amount of an agent** to the subject" (emphasis added) and the definition of "therapeutically effective amount of an agent" gives an example of using the same anti-TGF-beta antibody to treat and inhibit tumor recurrence (see page 16, lines 32-33). Thus, applicant's own specification equates treatment to inhibition/prevention. In paragraph 6 of the Declaration, applicant states that the recurrence tumor is a variant of the original tumor. This definition is not supported by the specification.

With respect to Barbera-Guillem applicant argues that the reference only discloses that the same compound is used to treat both the primary and the recurrent tumor and that this does not overcome the deficiency of the primary reference. Since applicant's own specification equates treatment to inhibition/prevention the reference reads on applicant's own definitions.

With respect to Rosenblum applicant argues that the reference cannot be predictive of the claimed methods because the reference uses a completely different antibody. This reference dislcoses that the same antibody used in treatment of tumors is used in the treatment of tumor recurrence Since applicant's own specification equates treatment to inhibition/prevention the reference reads on applicant's own definitions. Applicant also argues that the antibody of the claimed invention blocks an immunosuppressive effect of TGF-beta versus the direct targeting of the antibody of Rosenblum. The antibody of the primary reference (which is the same antibody used by applicant in the claimed invention) does suppress the immunosuppressive effects of

TGF-beta and thus since the secondary references show that the same antibody or antibody can be used to both treat and inhibit/prevent tumors and tumor recurrence, the antibody of the primary reference can also be used to both treat and inhibit/prevent tumors and tumor recurrence.

Claims 1, 6-11, 13-15, 21, 26-28, 32-34 and 38 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dasch et al US 6090383 in view of Barbera-Guillem US 6224866, Rosenblum US 2005/0214307 (filed 3/17/95) and Zavada et al US 6297041 and Suthanthiran et al US 2004-0197333 (filed 2/10/00). Please note: Zavada et al US 6297041 has been removed from this rejection. The reasons for this rejection are of record in the paper mailed 11/8/07.

Applicant's arguments have been addressed above.

Claims 1, 6-9, 11, 13-18, 21, 26-28, 32-34 and 38 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dasch et al US 6090383 in view of Barbera-Guillem US 6224866, Rosenblum US 2005/0214307 (filed 3/17/95) and Zavada et al US 6297041 and Terabe et al Nature Immunology vol. 1 p. 515 (12/00). Please note: Zavada et al US 6297041 has been removed from this rejection. The reasons for this rejection are of record in the paper mailed 11/8/07.

Applicant's arguments have been addressed above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dasch et al J. Immunol. Vol. 142 p. 1536 (1989).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is 571-272-0834. The examiner can normally be reached on Tuesday and Thursday from 5:30am to 1:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sheela J Huff/
Primary Examiner
Art Unit 1643

sjh